

REMARKS

Claims 1 and 3-10 are all the claims pending in the application. Claims 1, 8 and 10 have been amended based on, for example, page 17, lines 7-12 and Table 4 of the specification.

Applicants respectfully submit that with the entry of the proposed amendments, the present application will be in condition for allowance.

Accordingly, entry of the above amendments is respectfully requested.

I. Response to Rejection of Claims 1 and 5-10 under 35 U.S.C. § 103(a)

Claims 1 and 5-10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takaichi et al. (EP 0 443 047) in view of Bunger et al. (US 5,385,748), Takahata (US 4,212,893) and Chalupa et al. (US 5,597,604).

Applicants respectfully traverse the rejection.

It is respectfully submitted that the present invention is not taught or suggested by the cited art.

The Examiner asserts that Takahata discloses using gluconic acid and whole milk, which does not coagulate at the pH range of 2.5-4.5.

It is respectfully submitted that whole milk is not one of the recited protein materials of claim 1, and thus, even if Takaichi and Takahata were combined, the present invention according to claims 1, 8 and 10 would not be achieved.

The Examiner also asserts that Bunger teaches the combination of citric acid and phosphoric acids and Takahata discloses the use of citric acid and gluconic acid and combining acids. Thus, the Examiner asserts that the combination of acids is taught or suggested.

It is respectfully submitted that the combination of citric acid, gluconic acid and phosphoric acid is not taught or suggested by the references. Takahata discloses that more than one acid may be used, however, it does not disclose the specific combination of citric acid

and gluconic acid. In fact, Takahata discloses that citric acid and lactic acid are preferred and the Examples use either citric acid or a combination of citric acid and lactic acid. In addition, Bunker discloses that either citric acid or phosphoric acid, among other acids, can be used. Thus, neither reference teaches or suggests the specific combination of citric acid, phosphoric acid and gluconic acid. Accordingly, based on the disclosure of the references, one of ordinary skill in the art would not be led to arrive at the claimed combination.

For at least the above reasons, it is respectfully submitted that the present invention according to claims 1, 8 and 10, and the claims depending therefrom, are not taught or suggested by the cited art, and thus a *prima facie* case of obviousness has not been established.

With respect to unexpected results, the Examiner asserts that the data in the specification compares beverages within the scope of the claims with those outside the scope of the claims, and that the data shows that the claimed beverages is superior in terms of heat resistance. However, the Examiner asserts that the data is not persuasive given that there is only data at one value of each of the claimed ingredients and therefore the data is not commensurate in scope with the claims.

It is respectfully submitted that Applicants are not required to compare the claimed invention with subject matter that does not exist in the prior art. For example, in *In re Chapman*, the Court held that requiring Applicants to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. § 103 "would be requiring comparison of the results of the invention with the results of the invention." In this case, as acknowledged by the Examiner, Takaichi does not disclose, teach or suggest the claimed combination of acids.

Therefore, comparing the present invention to the Comparative Example is appropriate and shows unexpected results.

The Examiner further notes that the pH of the beverages are not disclosed and that the data is not persuasive given the results depend on the temperature and time (e.g., both beverages rate A at 75°C and 1-10 minutes), and since the claims do not recite any particular time and temperature, the data is not persuasive.

It is respectfully submitted that the pH is between the claimed range. With respect to the Examiner's assertion that the particular time and temperature is not recited in the claims, the claims need not recite that the claimed invention has superior heat stability at a certain temperature and time. That is, unexpected results need to be commensurate in scope with the claims, which means that the unexpected results must be due to the claimed features and not to the unclaimed features. Thus, it is submitted that the claims need not recite a particular temperature and time.

Moreover, an object of the present invention is to provide a nutritionally balanced, refreshing and low pH gel beverage composition for comprehensive nutritional supplementation that is in a soft gel form suitable for eating (drinking), and that is capable of stably retaining its form for a long period of time. As shown in Table 4 of the specification, the composition comprising the acid group of gluconic acid and phosphoric acid is superior to other compositions in low pH and sensory test scores.

Further, as can be seen from Tables 7 and 8 of the specification, the gel composition of the present invention comprising the acid group of gluconic acid and phosphoric acid shows high heat resistance. In other words, the combination of citric acid with gluconic acid and phosphoric acid is most suitable to achieve the gel beverage composition having the advantages and useful function described in the object. Such effects would not be expected by one of

ordinary skill in the art based on the disclosure of the cited art.

In view of the above, it is respectfully submitted that claims 1 and 5-10 are patentable over the cited art.

Accordingly, withdrawal of the rejection is respectfully requested.

II. Response to Rejection of Claims 3 under 35 U.S.C. § 103(a)

Claims 3 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takaichi further in view of Shimamura et al. (US 6,395,508).

Applicants respectfully traverse the rejection.

Claims 3 depends from claim 1, and thus, it is respectfully submitted that claim 3 is patentable for at least the same reasons as claim 1.

Accordingly, withdrawal of the rejection is respectfully requested.

III. Response to Rejection of Claims 1-9 under 35 U.S.C. § 103(a)

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Emoto (EP 1 046 347).

Applicants respectfully traverse the rejection.

The Examiner asserts that it would be obvious to one of ordinary skill in the art that if a protein that does not coagulate at low pH is employed, a gelling agent can be used to impose the gelling properties of the gel beverage, and that employing protein hydrolysates which do not coagulate at low pH is obvious. In this regard, the Examiner directs Applicants' attention to *In re Levin*, where the Court took the position that new recipes for formulas for cooking food which involves the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there

is nothing patentable unless the applicant, by a proper showing, further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected and useful function.

It is respectfully submitted that Emoto does not disclose the combined use of citric acid, gluconic acid and phosphoric acid, as recited in claims 1, 8 and 10. Thus, a *prima facie* case of obviousness has not been established because Emoto does not teach or suggest every element of the claims.

Additionally, Emoto is directed to a gelatinous food product and a feature of the invention lies in the food product "being a composite of an isoelectric gel of the protein". See Abstract and col. 1, lines 10-11. Emoto goes on to disclose that "[t]he protein, one of the ***essential*** ingredients of the gelatinous food product" and that "[i]t is necessary that the protein form an isoelectric gel at the pH of the food product of the invention, i.e., pH 3.3 to 4". Thus, the protein of Emoto is not a "common ingredient" and that the present invention does not involve the simple elimination of a common ingredient. Accordingly, the present situation can be distinguished from that of *In re Levin*.

Furthermore, the present invention exhibits a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected and useful function. That is, the coaction of the components, including the combination of acids, results in a composition having unexpectedly superior heat stability.

Moreover, as described above, the present invention achieves advantages and a useful function by a combination of specific components, which would not have been expected by one of ordinary skill in the art based on the disclosure of the cited art.

In view of the above, it is respectfully submitted that claims 1 and 8, and the claims depending therefrom, are patentable over the cited art.

Accordingly, withdrawal of the rejection is respectfully requested.

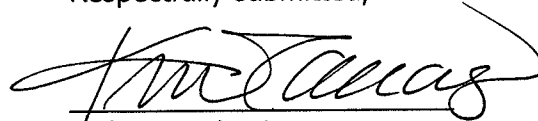
IV. Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1, 3 and 5-10 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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